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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,543	02/05/2004	Robert A. Luciano JR.	83336.1605	8942
66880 7590 04/21/2008 STEPTOE & JOHNSON, LLP 2121 AVENUE OF THE STARS SUITE 2800 LOS ANGELES, CA 90067				
EXAMINER				
BOND, CHRISTOPHER II				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kstowe@steptoe.com
emiyake@steptoe.com
jpcody@ballytech.com

Office Action Summary

Application No.

10/772,543

Applicant(s)

LUCIANO ET AL.

Examiner

CHRISTOPHER H. BOND

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendments and arguments filed September 18, 2007 have been entered. Claims 1-3 are currently amended. Claims 4-6 have been cancelled. Claims 7-20 are new. Currently, claims 1-3 and 7-20 are pending the application.

Claim Rejections - 35 USC § 112

2. The Examiner's prior 35 USC § 112, second paragraph rejection has been withdrawn due to the applicants' cancellation of claims 4 and 6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff USPAT 6,398,645 (hereinafter Yoseloff) in view of Marnell, II, USPAT 5,393,057 (hereinafter Marnell).**

5. In regards to applicant's claims 1 and 3, Yoseloff presents an electronic video bingo with multi-card play ability and discloses (column 2, lines 30-34), "The purpose of a display apparatus is to display several items or individual images or pieces of numerical information to the players such as the game number, the last number called, a record of numbers drawn, and the count of numbers called." This would meet the applicant's limitation of having a means for including at least the number of bingo balls in the bingo ball draws before ending each bingo game. Yoseloff further discloses

(column 6, line 52 – column 7, line 2), "...the gaming apparatus randomly chooses a second set of numbers from within said first set of numbers, said second set of numbers being smaller than said first set of numbers. The choice or selection/non-selection of bingo cards must of course be made prior to the display of the randomly selected second set of numbers or bingo ball. The apparatus (e.g., software or hardware) compares the second set of numbers to the numbers on each of the selected...bingo cards. The matching numbers (between the randomly selected second set of numbers and the numbers on the bingo cards) on at least the selected bingo cards are identified and recognized (e.g., displayed) by the apparatus on...the selected...hands. The apparatus then awards credits or money to the player for achieving any payout lines on any of the selected bingo cards." This would meet the applicant's limitation of receiving a wager from two or players to establish a gaming session in the bingo game, wherein the wager is exchange for a virtual bingo card, generating a bingo ball draw, and sending one or more balls from the bingo draw to the gaming machines until a winning event occurs at a bingo gaming terminal.

6. While Yoseloff discloses the method and system for playing an electronic bingo game, Yoseloff does not explicitly disclose a bingo bonus game system wherein the bingo presents the winning event from the bingo game as a game outcome of a non-bingo game of chance.

7. Marnell discloses (abstract), "An electronic gaming apparatus...including an electronic primary gaming device...such as a poker gaming device or a slot machine and an electronic secondary gaming device...The electronic poker gaming device...is

electrically coupled to the electronic secondary gaming device...and the primary gaming device...is responsive to the occurrence of selected events, such as poker hand or slot machine reel combinations, for the input into the secondary gaming device...Thus, the occurrence of poker hands in the poker gaming device...produces selection of space...in the bingo matrix...of a bingo-type gaming device..." Marnell further discloses (column 2, lines 9-13), "It is a further object of the present invention to provide an electronic gaming apparatus and method in which two games can be linked together, with the occurrence of events in one game being usable as an input to the other game." While Marnell discloses using the winning combinations of a primary game such as a slot machine or poker game to provide the input for use in a secondary game such as bingo, it would have been a matter of choice, well within the capabilities of one skilled in the art to use a bingo game as the primary game, which upon achieving a winning combination, provides an input to a poker game or slot machine as the secondary game, as this would have been a mere re-arrangement of the existing embodiments in Marnell. Additionally, Marnell discloses (column 8, line 33 - column 9, line 41) that different primary game winning combinations correspond to different secondary game outcomes. Marnell also discloses (column 2, lines 48-53) that a player may automatically be awarded an outcome of the secondary game corresponding to the outcome of a primary game, or may choose an outcome of the secondary game. This would correspond to the applicant's prize pool (different number of secondary game outcomes).

8. As to claim 2, Yoseloff discloses (column 5, lines 55-57), "The most traditional [bingo] game has 5x5 columns and rows from 10 to 20 different numbers available in

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each column..." This would meet the applicant's limitation of having a number of bingo balls corresponding to 50 in the case of having 10 different numbers in each of the 5 columns. This is however a design choice, as applicant has not disclosed that using 50 balls solves any stated problem or is for any particular purpose and it appears the invention would perform equally as well with a different number of balls. Furthermore, although Yoseloff does not mention a win pattern comprised of 4 corners as one of the payouts in his invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include this as one of the win patterns, since it has been long well known in the art that four corners is a common bingo win pattern.

9. As to claim 7, Yoseloff discloses (column 12, lines 25-26) that, "The games may be linked together with other machines to form a progressive jackpot." Which by the commonly understood notion of progressive jackpot, would meet the applicants' limitation of allocating a portion of the wagers received from the two or more players to a pool. Yoseloff however does not explicitly disclose allocating the progressive jackpot for use by the bonus game, and awarding players a bonus prize for the bonus win event, wherein the bonus prize is funded with money from the bonus pool (i.e. progressive jackpot).

10. Marnell discloses (column 2, lines 15-21) that the, "...object of the present invention is to provide an electronic gaming apparatus and method having a progressive payout in which a multiplicity of players can simultaneously play independent games and yet also can win the progressive payout by employing game-playing strategies in the play together of a progressive payout game." Marnell further discloses (column 10,

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lines 7-17), "Upon play of the bingo game by multiple players, and upon the occurrence of filling of spaces....in [the bingo] matrix...which meets the bingo criteria...the bingo game will be deemed complete. [The] Bingo microprocessor...can weight the proportion of the amount to be paid out...among the weighted input[s]...Thus...[a] "bingo"...with four-of-a-kind, would receive a greater proportion of the progressive bingo jackpot than would [a "bingo"]...which had input two pair." Again, as discussed above, while Marnell's invention discloses a poker/slot machine as the primary game, and the bingo game as the secondary game, it would have been a matter of choice, well within the capabilities of one skilled in the art, to rearrange the embodiments to make the bingo game the primary game and the poker/slot game the secondary game.

11. The advantage of linking the primary game to the secondary game by awarding game outcomes (inputs) for use in a secondary game as an award for the first game, Marnell writes (column 5, lines 8-14) is, "...to provide a new dimension of game strategy and greatly enhanced entertainment value of a progressive jackpot, [a] game apparatus...includes a secondary...gaming device...which is linked electrically to the primary...gaming device..."

12. This is evidence that one of ordinary skill in the art would have reason/motivation/suggestion to provide game outcomes for use in a secondary game as an award from the primary game as well as a progressive jackpot for the purpose of providing a new dimension of game strategy and enhancing entertainment value.

13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the electronic bingo device as described by

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Yoseloff with the method of providing game outcomes for use in a secondary game as an award from the primary game as well as a progressive jackpot, as described by Marnell, for the purpose of providing a new dimension of game strategy and enhancing entertainment value.

14. As to independent claims 8, 14, and 17, these claims, when viewed vis-a-vis Yoseloff in view of Marnell, are mere combinations of embodiments disclosed in both references and discussed above--with a teaching, suggestion, and motivation to combine these references also being given above.

15. As to claim 9, as discussed above, Marnell list both a primary and secondary game, and specifically lists slot machines and poker. Again, it would have been routine skill to one skilled in the art whether these games acted as the primary or secondary game.

16. As to claim 10-13, as discussed above, both references determine winning game combinations, and awarding a payout. Marnell, as discussed above, discloses the awarding of a payout from a bonus pool (progressive jackpot). This also includes allocating a portion of the wagers towards a bonus pool for bonus payouts (progressive jackpot), as described in Marnell, and presenting a non-bingo bonus game outcome (i.e. primary game winning combination generating secondary game inputs (i.e. prize pool) as an award) in response to winning the primary game, wherein the non-bingo bonus game outcome (input) corresponds to a prize selected from the prize pool.

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17. As to claim 15, as discussed above in Yoseloff in view of Marnell, a winning primary game outcome can correspond to a secondary game outcome selected from a prize pool.

18. As to claim 16, Yoseloff teaches drawing bingo balls at player terminals until a winning event occurs. Yoseloff in view of Marnell teaches the playing of a primary game (bingo) until a winning event occurs, which generates a secondary game (bonus game) and a winning event in the primary game acts as an input for the secondary game.

19. As to claim 18, as discussed above, Marnell disclosed the displaying of bonus outcome (secondary game inputs) as an outcome (input) of a non-bingo game-of-chance.

20. As to claim 19, as discussed above, both Yoseloff and Marnell disclose progressive jackpots. Marnell teaches a progressive jackpot used in combination with a secondary (bonus) game.

21. As to claim 20, Marnell discloses (column 4, lines 40-56) the use of a 'bet' button, which is understood in the art as being a button used to adjust the size of a player's bet. Marnell also discussed awarding a player a primary game outcome dependent on the value of that hand. It is well known in the art that game outcomes are usually dependent on the weighted probability of an outcome occurring in relation to the size of the bet--in simple terms, usually the amount of a bet multiplied by the likelihood of that outcome occurring, should a winning outcome occur (i.e. pay table). As discussed above in Marnell, Marnell teaches awarding different amounts from the prize pool based

on different combinations. As quoted above, Marnell discloses, "[The] Bingo microprocessor...can weight the proportion of the amount to be paid out...among the weighted input[s]...", which strongly suggests that the output is dependent on the input--in other words, the award is dependent on the wager.

Response to Arguments

22. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

23. Regarding the applicants' argument that Yoseloff does not teach the claimed invention, as discussed above, the Examiner has combined Yoseloff with Marnell to suggest the invention claimed by the applicant

Citation of Pertinent Prior Art

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Osawa, USPAT 6,699,122--which illustrates a primary game and secondary game--games which include poker, slot machines, and bingo, where a winning event in the primary game can be used as an input for the secondary game.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER H. BOND whose telephone number is (571)272-9760. The examiner can normally be reached on M-F 9:30am - 6pm (Eastern Standard Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Chris Bond/

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714